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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,065	09/26/2001	Imre Kovessi	212357	1431

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EXAMINER

PRIEBE, SCOTT DAVID

ART UNIT PAPER NUMBER

1632

DATE MAILED: 08/14/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,065

Applicant(s)

KOVESDI ET AL.

Examiner

Scott Priebe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44 and 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

The amendment filed 6/11/02 has been entered. Claims 36-43 and 45-47 have been cancelled. Claims 44 and 48 have been amended and are pending.

Priority

With Applicant's amendment of 6/11/02, claims 44 and 48 meet the requirements for priority under 35 USC 120 to 08/258,416.

Information Disclosure Statement

The information disclosure statement filed 2/19/02 fails to fully comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. WO 94/28152, has only been considered with respect to the contents of the Abstract, an English translation of which is present in each reference.

The information disclosure statement filed 2/19/02 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein as Ref.

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AZ, Brunet et al.; Ref. BJ, Grodzicker et al.; and Ref. BT, Roberts et al., have not been considered. These references were not provided during prosecution of the parent application 08/258,416, as indicated in the statement, nor has a copy of each been provided in the instant application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 48 remains rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-17, 32-46 and 53-58 of U.S. Patent No. 5,851,806. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 48 embraces the claimed adenovirus of claims 9-17 and 53-58 of the '806 patent, for example, as directed to the adenovirus of Examples 3 and 4.

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Claim 48 remains rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 7, 9-11, 14, 17, 19, 22 and 24 of U.S. Patent No. 5,994,106. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claims 36-43 and 45-48 embrace the subject matter of the claims of the '106 patent, for example, as directed to the adenovirus of Examples 3 and 4.

The following are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented. However, the '416 application has been allowed and is currently involved in interference proceedings, and the '797 application has been allowed.

Claims 44 and 48 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19, 20-26, 36-40, 43-56, 62-71, 76-95 of copending Application No. 08/258,416. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are directed to subject matter which embraces or is embraced by the claims of the '416 application.

Claim 48 remains provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-38, 52, 53, 68-70, 74, and 75 of copending Application No. 09/261,922. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '922

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application is directed to the subject matter of the instant claims, and the working examples which are also embraced by the instant claims, e.g. Examples 3 and 4.

Claim 48 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 69-78 of copending Application No. 09/321,797. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 48 is directed to the adenovirus of claims 69-78 of the '797 application when read in light of Example 4, for example.

This new rejection was necessitated, at least in part, by the amendment filed 7/17/02 in the '797 application. Co-pending application '797 has been allowed, and may issue before this application. Consequently, this rejection may not be withdrawn should all other rejections be overcome and this rejection be the only remaining issue. If this rejection should become the only remaining issue, this application will be suspended until the '797 application either issues or is abandoned. If the former, then this rejection will no longer be provisional.

Claim 48 remains provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36 and 42 of copending Application No. 09/766,405. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '405 application embrace the

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subject matter of the instant claims, and the working examples, e.g. Ex. 3 and 4, which are also embraced by the instant claims.

Claim 48 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36, 39, 40, 42, 44- 46, 49, 50, 52, 54 and 55 of copending Application No. 09/934,207. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 48 is directed embraces the claimed subject matter of the '207 application, especially when read in light of Examples 3 and 4.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed 6/11/02 have been fully considered but they are not persuasive. Applicant argues that the provisional double-patenting rejections may be withdrawn as being the only remaining issues. However, the obviousness-type double patenting rejections over the '806 and '106 patents are not provisional, nor have any arguments been presented traversing these rejections. Also, the newly made provisional rejection over the '797 application cannot be withdrawn as this application has been allowed.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. The newly presented grounds of rejection based upon the obviousness-type double patenting will not preclude the finality of this Office action. These grounds of rejection involve conflicting claims in co-pending application Serial No. 09/934,207 sharing the same inventive entity with the instant application, newly discovered by Examiner. The co-pending application is clearly related to the present application, and thus clearly material to the examination thereof. Applicants' will not be permitted to extend the prosecution of the present application by reason of their failure to notify the Office of conflicting claims in co-pending applications, as required under 37 CFR 1.56 (see MPEP 201.06(b)), the discovery of which necessitated the new grounds of rejection at this advanced point in the prosecution. With appropriate notice in an Information Disclosure Statement these grounds of rejection clearly could have been presented in a prior Office action. This situation is clearly analogous to the policy of making final an action where applicant's material amendments to the claims necessitated a new ground of rejection, see MPEP 706.07(a), and where applicant's submission of information with a fee under 37 CFR 1.97(c) necessitated new grounds of rejection of claims, whether amended or not, see MPEP 609 B(2)(I), since in these instances it is an action or inaction on the part of applicant which caused the rejection to be applied after the case had received an action on the merits. See MPEP § 706.07(a). Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

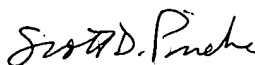
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Certain papers related to this application may be submitted to Art Unit 1632 by facsimile transmission. The FAX numbers are (703) 308-4242 or (703) 305-3014 for any type of communication. In addition, FAX numbers for a computer server system using RightFAX are also available for communications before final rejection, (703) 872-9306, and for communications after final rejection, (703) 872-9307, which will generate a return receipt. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott D. Priebe whose telephone number is (703) 308-7310. The examiner can normally be reached on Monday through Friday from 8 AM to 4 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051.

Any inquiry concerning administrative, procedural or formal matters relating to this application should be directed to Patent Analyst Patsy Zimmerman whose telephone number is (703) 308-8338. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



SCOTT D. PRIEBE, PH.D
PRIMARY EXAMINER